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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,866	01/18/2002	Kiyoshi Yoshizumi	218209US3	9246
22850	7590	09/28/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HODGE, ROBERT W	
			ART UNIT 1795	PAPER NUMBER
			NOTIFICATION DATE 09/28/2009	DELIVERY MODE ELECTRONIC

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In re application of  
Yoshizumi et al.  
Serial No. 10/050,866  
Filed: January 18, 2002  
For: ONBOARD FUEL CELL SYSTEM BAND METHOD OF DISCHARGING  
HYDROGEN-OFF GAS

DECISION ON  
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.144 REQUESTING WITHDRAWAL OF THE RESTRICTION REQUIREMENT made final in the Office action mailed June 4, 2009.

On March 2, 2009, the Examiner made a Restriction/Election requirement. The election of species requirement as set forth by the Examiner required Applicant to fully elect one species for the valve control and one species for how the off gas(es) is/are fed to the missing portion.

Applicant responded to the requirement in a response filed on April 30, 2009. In the response, Applicant elected with traverse the species of embodiment 3a and 3b (as identified in the restriction requirement) and indicated that claims 1, 8, 13-15, 37-39 and 51-67 read on the elected species. A final Office action was mailed on June 4, 2009 which further considered claims 13, 54-57 and 59-62 to be withdrawn as being directed to a non-elected species.

On September 3, 2009, the present petition requesting withdrawal of the restriction requirement of March 2, 2009 be withdrawn. The present petition also traverses the Examiner's withdrawal of claims 13, 54-57 and 59-62.

## DECISION

Section 806.04(f) of the MPEP states:

### 806.04(f) [R-3] Restriction Between Mutually Exclusive Species

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. **This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.** (Emphasis added).

Petitioner argues that both election of species requirements in the March 2, 2009 restriction are improper because both species are not mutually exclusive. This is extensively argued in the original traversal of April 30, 2009, as well as in the current petition (see pages 2-4). The petitioner's argument is persuasive for the reasons set forth in the present petition. Additionally,

as argued by the petitioner, the asserted burden that the different species “are likely to raise different non-prior art issues under 35 USC 101 and/or 35 USC 112, first paragraph” is grossly improper. The Examiner is directed to MPEP 808.02, which states that the he/she must establish a serious burden by showing by appropriate explanation one of the following: (A) separate classifications, (B) separate status in the art when they are classifiable together or (C) a different field of search.

Accordingly, the petition is **GRANTED**. A Request for Continued Examination was filed on September 3, 2009. The next Office action by the Examiner will withdraw the restriction requirement of March 2, 2009 and include an action on the merits over claims 1, 8, 13-15, 37-39 and 51-67.

/Gregory L Mills/

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